

PP23697.001; 20366-005001  
SERIAL NO.: 10/085,117

PATENT  
FILED: February 27, 2002

#### REMARKS

Claims 1-19 were pending in the application. Claims 1-19 have been cancelled without prejudice to presentation in future related applications. New claims 20-31 have been added.

Support for new claims 20-31 can be found throughout the application as originally filed.

No new matter has been added.

Upon entry of this amendment, claims 20-31 will be pending.

#### Restriction Requirement

Claims 1-19 are subject to a restriction requirement. The Examiner required Applicants to elect one of twelve allegedly patentably distinct inventions for examination. The Office also required the election of a single gene or polypeptide sequence. Applicants respectfully traverse on the grounds that searching more than one of the groups set forth by the Office would pose no serious burden on the Examiner.

Preliminarily, Applicants note that claims 1-19 have been cancelled without prejudice, rendering the Restriction Requirement moot to the extent it was directed to Groups I-II, VII, and X-XII.

MPEP §803 sets forth criteria for determining when restriction is proper, stating, *inter alia*, that “[i]f the search and examination of all the claims in an application can be made without serious burden, the examiner must examine them on the merits, even though they include claims to independent or distinct inventions.” Applicants respectfully assert that claims 20-31 can be searched and examined without serious burden. Applicants respectfully assert that searching more than group, in particular, Groups III and VI, would not constitute a serious burden. Applicants point out that the same field of search is appropriate for each invention. Indeed, Applicants note that the Office has required the election of a single sequence; given that only one specific sequence will be searched, that single sequence search will provide results relevant for both Group III and Group VI.

PP23697.001; 20366-005001  
SERIAL NO.: 10/085,117

PATENT  
FILED: February 27, 2002

Although Applicants respectfully traverse the restriction requirement on the grounds that examining more than one invention would not constitute a serious burden, Applicants provisionally elect herein Group VI, drawn to a "method of diagnosing cancer . . .", classified in class 424, subclass 9.1. Applicants elect for examination human EGR1 mRNA (SEQ ID NO:167).

Applicants reserve the right to prosecute the claims encompassed by any of the non-elected groups in future divisional applications.

**Change of Correspondence Address**

As set forth on the attached "Change of Correspondence Address" form SB-122, Applicants respectfully request that all future correspondence related to this application be directed to:

Customer Number 55255  
SAGRES DISCOVERY INC.  
Intellectual Property - R440  
P.O. Box 8097  
Emeryville, CA 94662-8097

PP23697.001; 20366-005001  
SERIAL NO.: 10/085,117

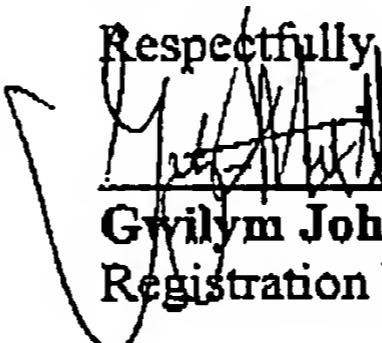
PATENT  
FILED: February 27, 2002

**Conclusion**

The examination of the pending claims and passage to allowance are respectfully requested. An early Notice of Allowance is therefore earnestly solicited. Applicants invite the Examiner to contact the undersigned at (302) 778-8458 to clarify any unresolved issues raised by this response.

No fee is believed due for the Response to Restriction Requirement. Please apply any charges or credits to Deposit Account No. 06-1050.

Respectfully submitted,

  
Gwilym John Owen Attwell  
Registration No. 45,449

Date: March 20, 2006  
Fish & Richardson P.C.  
P.O. Box 1022  
Minneapolis, MN 55440-1022  
(302) 652-5070 telephone  
(877) 769-7945 facsimile

80031458.DOC